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10/589,697

05/20/2008

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EXAMINER

CULBRETH, ERIC D

ART UNIT

PAPER NUMBER

3616

MAIL DATE

DELIVERY MODE

10/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/589,697 | Applicant(s) GARZKE ET AL. | |
| | Examiner Eric Culbreth | Art Unit 3616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/16/06&5/20/08</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steering column tube unit and clamping apparatus (claim 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it should be on a clean sheet of paper (the reference characters and “DaimlerChrysler AG” at the top of the page should be deleted, as should “(Figure 1)” at the bottom). Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

a. In paragraph [0022], line 9 “8” should be “8a, 8b” (there is no reference character 8 on the drawings).

b. In paragraph [0030], line 13 “right-hand” should apparently be “left-hand” (the opposite side was called right-hand earlier in the paragraph).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, it is not clear what part of the invention is the clamping apparatus with which the steering column tube unit is arranged between the two limbs. If it is a bolt through slots in the limbs, then the fastening element of claim 24 which depends

Art Unit: 3616

from claim 13 ultimately is a double inclusion. In fact, the two limbs would appear to make up the clamping apparatus along with a bolt, and if this is the case, the recitation in claim 13 of a clamping apparatus is a double inclusion of the limbs (i.e., the claim should be amended to recite that the limbs are part of or make up a clamping apparatus).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

8. Claims 13, 15-16, 19, 21, 27, 29 and 30 as best understood are rejected under 35 U.S.C. 102(e) as being anticipated by German Published Application 10318034A1 (of record, cited by applicant).

(German '034 is the foreign priority document and hence the equivalent of US 20060267328A1, so the US publication will be used for its English disclosure.)

Art Unit: 3616

German '034 discloses a steering column arrangement for a motor vehicle comprising a steering column tube unit (steering column of a motor vehicle in lines 1-2 of the English document, tube at paragraph [0010], line 10 of English document), bracket 1 by which the column unit is fastened to a vehicle body and can be adjusted for comfort purposes, the bracket having two limbs 2, 3. Bolt 6 is a clamping apparatus with which the steering column is arranged between the two limbs, and the limbs have different rigidities (paragraph [0010], lines 11-24 of English document)(claim 13). Regarding claims 15-16, 19, 27, 29 and 30, the bracket is asymmetric in a region of the limbs (one limb is thicker than the other), and each limb has a supporting region along slots 7 and a bearing region at the top as broadly recited. Regarding claim 21, each limb has a smaller width (from front to back) in its supporting region along the slots than in its bearing region at the top.

9. Claims 13, 15-16, 19, 21-22, 27, 29 and 30 as best understood are rejected under 35 U.S.C. 102(e) as being anticipated by Lee US007252019B2.

Lee discloses a steering column arrangement for a motor vehicle comprising a steering column tube unit (best seen in Figure 4), bracket 100 by which the column unit is fastened to a vehicle body and can be adjusted for comfort purposes, the bracket having two limbs 102, 200. A bolt best seen in Figure 4 is a clamping apparatus with which the steering column is arranged between the two limbs, and the limbs have different rigidities (column 3, lines 34-40)(claim 13). Regarding claims 15-16, 19, 27, 29 and 30, the bracket is asymmetric in a region of the limbs (one limb is thicker than the

Art Unit: 3616

other), and each limb has a supporting region at the bottom with slots 7 and a bearing region at the top. In regard to claim 21, each limb in Figure 3 has a smaller width (from front to back) in its supporting region (the region containing the slots) than in its bearing region at the top, as broadly recited. Regarding claim 22, one limb has a recess in the supporting region (the recess in Figure 3 on coupling portion 101 in the supporting region of the limb, between the illustrated rivets).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3616

12. Claims 14, 17-18, 20, 23-26, 28 and 31-32 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over German '034 in view of German Published Application 10161849, cited by applicant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify German '034 to include a frame and stiffening ribs as taught by German 849's bracket at 4 in Figure 1 in order to conventionally make the bracket strong but lightweight, as hollow frames and ribs are typically used for this purpose and would yield predictable results (claim 14). Regarding claims 17-18, 20, 28 and 31-32, in the combination, in the region of German '849's limbs ribs e'ten' at least perpendicular to the limbs in Figure 2 at the front and rear of the widest part of the bracket, and the ribs are at a smaller spacing from one another in the region of the top limb in Figure 2 than in the region of the bottom limb (i.e., there are two diagonal ribs on the left side of the top limb in Figure 2 closer to each other than the one diagonal limb to the left of the bottom limb); the limbs are reinforcements near the top of the limbs, which can be the supporting regions (although the top of German '034 was the bearing region earlier; the claims are so broad that the top of the limbs can be the bearing region or the supporting region). As best understood, German '034's slots 7 accommodate fastening element 6 (claims 23-24), and German '034's limbs 2, 3 are asymmetrical as they are different in thickness (claims 25-26).

Art Unit: 3616

13. Claims 14, 17-18, 20, 23-26, 28 and 31-32 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of German Published Application 10161849, cited by applicant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lee to include a frame and stiffening ribs as taught by German 849's bracket at 4 in Figure 1 in order to conventionally make the bracket strong but lightweight, as hollow frames and ribs are typically used for this purpose and would yield predictable results (claim 14). Regarding claims 17-18, 20, 28 and 31-32, in the combination, in the region of German '849's limbs ribs e'ten' at least perpendicular to the limbs in Figure 2 at the front and rear of the widest part of the bracket, and the ribs are at a smaller spacing from one another in the region of the top limb in Figure 2 than in the region of the bottom limb (i.e., there are two diagonal ribs on the left side of the top limb in Figure 2 closer to each other than the one diagonal limb to the left of the bottom limb); the limbs are reinforcements near the top of the limbs, which can be the supporting regions (although the top of German '034 was the bearing region earlier; the claims are so broad that the top of the limbs can be the bearing region or the supporting region). As best understood, German '034's slots 7 accommodate fastening element 6 (claims 23-24), and German '034's limbs 2, 3 are asymmetrical as they are different in thickness (claims 25-26).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lee US007125047B2 (Figure 7), Ben Rhouma et al US007367246B2 (Figure 4), British Patent 2,116,496 and Klukowski et al US007387045B2 (Figures 4-5) show asymmetric limbs so that they have different rigidities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Culbreth whose telephone number is 571/272-6668. The examiner can normally be reached on Monday-Thursday, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 571/272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Culbreth
Primary Examiner
Art Unit 3616

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